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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,262	04/19/2000	Jerry Dunietz	03797.87364	4106
28319 7590 12/29/2006 BANNER & WITCOFF LTD., ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1001 G STREET, N.W. SUITE 1100 WASHINGTON, DC 20001-4597			EXAMINER BASHORE, WILLIAM L	
			ART UNIT 2176	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			12/29/2006	
			DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/552,262

Applicant(s)

DUNIETZ ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/19/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Appeal Brief filed 10/10/2006. Prosecution is hereby reopened in view of newly applied art.
2. Claims 1-35 pending. Claims 1, 10, 12, 14, 16, 19, 24, 32 are independent.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 5, 7, 9, and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (hereinafter "Tada"), US 5,745,745 patented 4/28/1998.**

Regarding independent claim 1 and dependent claim 9, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with an alias in col. 22 lines 6-20. Tada teaches in col. 22 line 24 - col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not. Tada teaches in col. 6 lines 30 - col. 7 line 20 that these enhancements enable more efficient searching by excluding unnecessary sections of the text. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 - col. 12 line 5.

While Tada teaches a relation maintained between the alias and the flag, Tada does not forcefully disclose a “*separation variable*” for separating a tag from content. However, Tada teaches replacing a start tag with a control code variable “ α ” (Tada column 22 lines 24-28), providing reasonable suggestion to the skilled artisan that said tag is “separated” and using said code to also reflect replacement (separation from content) accordingly, providing the benefit of separation variables to clearly distinguish separation.

Although Tada does not forcefully teach “*inserting at least one flag within the tag...*”, nevertheless, Tada teaches a relation maintained between tags (alias), flags (control codes/variables) along with logical structure identification numbers (see also Tada at least Figures 11, 12, 15, 28), providing reasonable suggestion to the skilled artisan of insertions, so as to facilitate correct references within the encoded structure.

Regarding dependent claim 2, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing at least one attribute type within the tag with an attribute alias, wherein the attribute alias is a predefined representation for the attribute type in col. 22 lines 6-20.

Regarding dependent claim 5, Tada teaches inserting a position flag to indicate whether the tag is a start tag or an end tag in col. 22 lines 6-20.

Regarding dependent claim 7, Tada teaches inserting a no search flag in association with a portion of the content information, whereby a no search field may be readily identified and skipped during a run-time linear search in col. 22 line 24 - col. 23 line 24.

Regarding independent claim 16 and dependent claim 18, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with an alias whereby the tag may be readily

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identified during run-time parsing of the document in col. 22 lines 6-20. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 - col. 12 line 5.

While Tada teaches a relation maintained between the alias and the flag, Tada does not forcefully disclose a "*separation variable*" for separating a tag from content. However, Tada teaches replacing a start tag with a control code variable " α " (Tada column 22 lines 24-28), providing reasonable suggestion to the skilled artisan that said tag is "separated" and using said code to also reflect replacement (separation from content) accordingly, providing the benefit of separation variables to clearly distinguish separation.

Although Tada does not forcefully teach "*inserting at least one flag within the tag...*", nevertheless, Tada teaches a relation maintained between tags (alias), flags (control codes/variables) along with logical structure identification numbers (see also Tada at least Figures 11, 12, 15, 28), providing reasonable suggestion to the skilled artisan of insertions, so as to facilitate correct references within the encoded structure.

Regarding dependent claim 17, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing at least one attribute type within the tag with an attribute alias, wherein the attribute alias is a predefined representation for the attribute type in col. 22 lines 6-20.

Regarding independent claim 19, Tada teaches a tag having encoded therein a predefined integer alias for the tag in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with the alias in col. 22 lines 6-20. Tada teaches a content portion associated with the tag in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 - col. 12 line 5.

While Tada teaches a relation maintained between the alias and the flag, Tada does not forcefully disclose separating a tag from content. However, Tada teaches replacing a start tag with a control code variable

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" α " (Tada column 22 lines 24-28), providing reasonable suggestion to the skilled artisan that said tag is "separated" and using said code to also reflect replacement (separation from content) accordingly, providing the benefit of separation variables to clearly distinguish separation.

Regarding dependent claim 20, Tada teaches wherein the tag further includes at least one flag wherein the flag is selected from the group consisting of WORDBREAK, NOSEARCH, STARTTAG, and ENDTAG in col. 22 line 24 - col. 23 line 24.

Regarding dependent claim 21, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches wherein the tag further includes at least one pre-defined attribute type alias in col. 22 lines 6-20.

5. Claims 3, 4, 8, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada as applied to claims above, and further in view of Open eBook Publication Structure 1.0" published 9/16/1999 (hereinafter "Open eBook").

Regarding dependent claim 3, Tada does not teach UTF-8 encoding the first encoded document to form a second encoded document. Open eBook does teach UTF-8 encoding the first encoded document to form a second encoded document in section 1.4.6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings Open eBook and Tada to have created the claimed invention. It would have been obvious and desirable to have used UTF-8 encoding taught by Open eBook to have created a second document so that it only uses half of the space a UTF- 16 document would require. This would have been desirable and beneficial for using less storage space and taking

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less time to transmit the file.

Regarding dependent claim 4, Tada teaches compressing an encoded document to form a compressed document in col. 6 lines 4-29.

Regarding dependent claim 8, Tada teaches replacing a tag with a reference string alias in col. 22 lines 6-20. Tada does not teach replacing a URL within content information with a reference string, whereby the file referenced by the URL may be readily accessed when selected during run-time. Open eBook is partially based on HTML 4.0 as taught in sections 1.4.3 and 3. Thus, Open eBook teaches replacing a URL with a reference string, whereby the file referenced by the URL may be readily accessed when selected during run-time, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tada and Open eBook to have created the claimed invention. It would have been obvious and desirable to implement the Open eBook teaching of replacing a URL with a reference string so that the user could have selected a descriptive reference string instead of a non-descriptive URL at run-time.

Regarding dependent claim 22, Tada does not teach wherein the markup language document is UTF-8 encoded. Open eBook does teach wherein a markup language document is UTF-8 encoded in section 1.4.6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings Open eBook and Tada to have created the claimed invention. It would have been obvious and desirable to have used UTF-8 encoding taught by Open eBook to have encoded the markup language document so that it only uses half of the space a UTF-16 document would require. This would have been desirable and beneficial for using less storage space and taking less time to transmit

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the file.

Regarding dependent claim 23, Tada teaches compressing an encoded document to form a compressed document in col. 6 lines 4-29.

6. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tada as applied to claim 1 above, and further in view of Carus et al. (hereinafter "Carus"), US 6,035,268 provisional filed 8/22/1996.**

Regarding dependent claim 6, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with an alias in col. 22 lines 6-20. Tada teaches in col. 22 line 24 - col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not. Tada teaches in col. 6 lines 30 - col. 7 line 20 that these enhancements enable more efficient searching by excluding unnecessary sections of the text. Thus, Tada teaches pre-computing a text to improve run-time search operation as is further described in col. 6 lines 30 - col. 7 line 20. Tada teaches an implementation on a computer readable medium in fig. I and col. 11 line 39 - col. 12 line 5.

Tada does not teach comparing a left and right term to determine if they are part of a single word and if they left and right terms are not part of a single word, inserting a word break flag between the left and right terms. Carus does teach comparing a left and right term to determine if they are part of a single word and if they left and right terms are not part of a single word, inserting a word break flag between the left and right terms in col. 2 line 62 - col. 3 line 31 and col. 5 lines 51-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tada and Carus to have

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created the claimed invention. Carus notes that identifying the word breaks is a computationally expensive process in col. 2 lines 46-61. Thus, it would have been obvious and desirable to have implemented the word break identification of Carus in the text search improvement pre-processing so that the computationally expensive step of identifying word breaks would have been performed prior to the run-time search. Since Tada is also trying to pre-process text to improve run-time performance by reducing the run-time computational burden, this combination would have been very desirable to one of ordinary skill in the art at the time of the invention.

7. **Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada, in view of Carus et al. (hereinafter "Carus"), US 6,035,268 provisional filed 8/22/1996.**

Regarding independent claim 10 and dependent claim 11, Tada teaches identifying tags in a document having markup language content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches replacing the tag with an alias in col. 22 lines 6-20. Tada teaches in col. 22 line 24 - col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not. Tada teaches in col. 6 lines 30 - col. 7 line 20 that these enhancements enable more efficient searching by excluding unnecessary sections of the text. Thus, Tada teaches pre-computing a text to improve run-time search operation as is further described in col. 6 lines 30 - col. 7 line 20. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 - col. 12 line 5.

Tada does not teach comparing a left and right term to determine if they are part of a single word and if they left and right terms are not part of a single word, inserting a word break flag between the left and right terms. Carus does teach comparing a left and right term to

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determine if they are part of a single word and if they left and right terms are not part of a single word, inserting a word break flag between the left and right terms in col. 2 line 62 - col. 3 line 31 and col. 5 lines 51-67. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Tada and Carus to have created the claimed invention. Carus notes that identifying the word breaks is a computationally expensive process in col. 2 lines 46-61. Thus, it would have been obvious and desirable to have implemented the word break identification of Carus in the text search improvement pre-processing so that the computationally expensive step of identifying word breaks would have been performed prior to the run-time search. Since Tada is also trying to pre-process text to improve run-time performance by reducing the run-time computational burden, this combination would have been very desirable to one of ordinary skill in the art at the time of the invention.

8. **Claims 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (hereinafter "Tada"), US 5,745,745 patented 4/28/1998.**

Regarding independent claim 12 and dependent claim 13, Tada teaches identifying a tag within a document associated with a portion of content in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Tada teaches in col. 22 line 24 - col. 23 line 24 inserting a control code, which is a flag, to form an encoded structure indicating whether the information contained within the tags should be searched or not. Tada teaches in col. 6 lines 30 - col. 7 line 20 that these enhancements enable more efficient searching by excluding unnecessary sections of the text. Thus, Tada teaches pre-computing the text to improve run-time search operations. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39 - col. 12 line 5.

Tada does not teach that the no search flag is conditionally inserted based on determining

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whether the portion is to be displayed for viewing by a reading device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Tada to have created the claimed invention. It would have been obvious and desirable to have used the search exclusion technique of Tada to have excluded portions which are not to be displayed by a viewing device from searching. This would have corresponded to the goal of Tada of improving run-time search operations as described in col. 6 lines 30 - col. 7 line 20.

9. **Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Open eBook Publication Structure 1.0" (hereinafter "Open eBook") published 9/16/1999.**

Regarding independent claim 14 and dependent claim 15, Open eBook teaches a document structure partially based on XML, HTML, and other document technologies in section 1.4 pages 3-7. Thus, Open eBook teaches using and identifying Uniform Resource Locators (URL) within a document. Open eBook teaches in section 2.3 on page 18 a manifest file which contains both a URL and an associated reference string. Open eBook describes a computer readable medium implementation in the reading device definition in section 1.3 on page 2. Open eBook does not specifically teach replacing part of a URL identified in the document with the reference string and a flag for the file. However replacing a URL with a reference string is described was known by the linking technology of HTML at the time of the invention on which Open eBook is partially based. This allowed a the string to be displayed and the actual details of the URL hidden fi'om display, but appended to the string. When the string was selected by a user, the URL was activated. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Open eBook to have created the claimed invention. It would have been obvious and desirable to have modified Open eBook to have replaced URLs in the document with the associated reference string so that the link would have

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been more descriptive to the user.

10. Claims 24-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Open eBook Publication Structure 1.0" published 9/16/1999 (hereinafter "Open eBook") in view of Tada et al. (hereinafter "Tada"), US 5,745,745 patented 4/28/1998.

Regarding independent claim 24, Open eBook teaches a root directory in sections 2 and 2.1 on pages 11 and 12. The package element is the outermost element in a package file and all other elements are nested within it, thus it is the root directory. Open eBook teaches a content subdirectory linked to the root directory, the content subdirectory having nested therein at least one linked content file providing content information relating to the electronic book in sections 2 and 2.1 on pages 11 and 12. The package element is the outermost element in a package file and all the other elements are nested within it, thus the other elements are contained in a subdirectory linked to the root directory. The subdirectory is described by the manifest, which Open eBook describes in section 2.3.

Open eBook does not teach wherein the content file is pre-computed and encoded to minimize run-time requirements. Tada does teach a content file which is pre-computed and encoded to minimize run-time requirements in col. 1 lines 7-13, col. 21 lines 50-64, col. 22 lines 6-20, and col. 22 line 24 - col. 23 line 24. Tada teaches in col. 6 lines 30 - col. 7 line 20 the advantage of decreased search time as a result of pre-computing and encoding the content file. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Open eBook and Tada to have created the claimed invention. It would have been obvious and desirable to have used the content file pre-computing and encoding as taught by Tada to have enabled fast run-time search operations on a the Open eBook, which is often implemented on a low power portable reading device.

Regarding dependent claim 25, Open eBook teaches at least one link destination index file linked to the content file in section 2.3 page 18.

Regarding dependent claim 26, Open eBook teaches a page break index providing an index of page break corresponding to the electronic book in sections 2.3, 2.4 and 2.6 pages 18, 19, and 21.

Regarding dependent claim 27, Open eBook teaches a metadata file linked to the root directory and having information about the electronic book in sections 2.2 pages 12-17.

Regarding dependent claim 28, Open eBook teaches a manifest file linked to the root directory providing a listing of the files in the content subdirectory relating to the electronic book in section 2.3 page 18.

Regarding dependent claim 29, Open eBook teaches using at least one Cascading Style Sheet (CSS) file in section 4 pages 39-47.

Regarding dependent claim 30, Open eBook teaches a metadata file linked to the root directory and having information about the electronic book in sections 2.2 pages 12-17.

Regarding dependent claim 31, Open eBook teaches a digital rights management database linked to the root database in sections 2 and 2.1 pages 11 and 12.

Regarding independent claim 32 and dependent claim 35, Open eBook teaches a root directory in sections 2 and 2.1 on pages 11 and 12. The package element is the outermost element in a package file and all other elements are nested within it, thus it is the root directory. Open eBook teaches a content subdirectory linked to the root directory, the content subdirectory having nested therein at least one linked content file providing content information relating to the electronic book in sections 2 and 2.1 on pages 11 and 12. The package element is the outermost element in a package file and all the other elements are nested within it, thus the other elements are contained in a subdirectory linked to the tool directory. The subdirectory is described by the manifest, which Open eBook describes in section 2.3.

Open eBook does not teach converting a document in a first format by processing the document to pre-compute and encode the markup language within the document. Tada does teach converting a document in a first format by processing the document to pre-compute and encode the markup language within the document in col. 1 lines 7-13, col. 21 lines 50-64, col. 22 lines 6-20, and col. 22 line 24 - col. 23 line 24. Tada teaches an implementation on a computer readable medium in fig. 1 and col. 11 line 39- col. 12 line 5. Tada teaches in col. 6 lines 30- col. 7 line 20 the advantage of decreased search time as a result of pre-computing and encoding the document into a converted document. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Open eBook and Tada to have created the claimed invention. It would have been obvious and desirable to have used the document pre-computing and encoding as taught by Tada to have enabled fast run-time search operations on a the Open eBook, which is often implemented on a low power portable reading device.

Regarding dependent claim 33, Open eBook teaches wherein the first format is an Open E-Book format in section 2 pages 11-21.

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Regarding dependent claim 34, Open eBook teaches wherein the document is an electronic book in section 2 pages 11-21.

Response to Arguments

11. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection. It is noted that the Fontaine reference is no longer relied upon.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 1:00pm - 9:30pm EST.

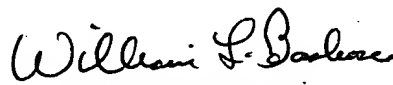
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

14 Supervisory approval has been granted for reopening of this case after filing of Appeal Brief on 10/10/2006, as indicated herewith.


STEPHEN HONG
SUPERVISORY PATENT EXAMINER


WILLIAM BASHORE
PRIMARY EXAMINER

December 22, 2006